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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,186	06/16/2000	Janez Funda	017516-006110US	6794
51947	7590	12/13/2007	EXAMINER	
PATENT DEPT INTUITIVE SURGICAL, INC 1266 KIFER RD BUILDING 101 SUNNYVALE, CA 94086			CATTUNGAL, SANJAY	
		ART UNIT	PAPER NUMBER	
		3768		
		MAIL DATE	DELIVERY MODE	
		12/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/595,186	FUND A ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sanjay Cattungal	3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 January 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 44-64 is/are pending in the application.  
 4a) Of the above claim(s) 50-64 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 44-49 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. During a telephone interview with Mr. Frank Nguyen, applicant and the examiner reached an agreement that the election/restriction requirement sent on 04/07/06 is withdrawn as the newly submitted claims 44-64, had a group 50-64 which was directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 44-49, drawn to a method of controlling the position of a surgical instrument inside a patient's body, classified in class 600, subclass 425.
- II. Claims 50-64, drawn to drawn to a robotic system and method of positioning for one or more surgical instruments with manipulators relative to a patient's body, classified in class 700, subclass 259.

2. Since applicant has received an action on the merits for the originally presented invention on 09/16/2003, this invention group I has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 50-64 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant reserves the right to file a divisional with the canceled claims 50-64.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**4. Claims 44 and 45 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Abela et al. (Pat # 5,036,463)**

5. The system Abela et al. teaches an angioscopic method that can designate the 3 dimensional distance of a point within the body relative to the tip of the angioscope. Column 12 lines 44 through column 13 line 56 describes the positional information that is obtained by the angioscope. The angioscope is interpreted as the first surgical instrument having means of transmitting an image outside the body. Further the point or object or scene as recited by Taylor is interpreted as the anatomical feature. Finally the recitation to manipulation of the instrument, column 12 lines 64-67, of Taylor incorporates the positioning of the first surgical instrument. Figure 10 diagrams the image-processing scheme for determining the 3-D positional information.

**6. Claims 44-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor (Pat# 5,402,801)**

7. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

8. The apparatus of Taylor, specifically Fig. 10, teaches providing the method of controlling the position of a surgical instrument as claimed in 44-46. An system 242 comprises a surgical first instrument 254 that has imaging transmitting 266 for satisfying the applicant's limitation to a first surgical instrument transmitting an image out of the patient's body. Column 21 lines 34-41 of Taylor teach that the surgeon can designate a particular anatomical feature within the image. The transmitting image is sent to a monitor for display and to a image processor and/or computer. As taught by the applicant claims the image processor and/or computer provides relative positional information of the surgical instrument to the patient's anatomy (specifically to an anatomical feature when designated). The positional information includes location and orientation therefore providing 3-D positional information as taught by applicant. The positional information is used to move the surgical instrument to desired locations and/or to provide the desired graphical display of the anatomical feature. Regarding claim 46, Taylor teaches that a second surgical instrument can further be incorporated into the system and it's position or reposition is satisfied by the same methods as that of the first surgical instrument.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 47-49 are rejected under 35 U.S.C. 103(a) as being obvious over Taylor (Pat# 5,402,801 ).**

11. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

12. The system of Taylor satisfies the methods of controlling the positioning a surgical instrument within a patient's body as claimed in 47-49.

13. Regarding claims 47 Taylor teaches that surgical instrument can move in a  $\theta_x$ ,  $\theta_y$ , and  $\theta_z$  position. A desired anatomical feature can be designated the instrument can

be located such that the camera scans the over an indicated path. The indicated path is interpreted as a vantage point as claimed by applicant. Further a feature "zoom" is taught by the patent such that the surgical instrument moved along an axis of view as claimed by applicant.

14. Regarding claim 48 Taylor does not teach providing a constant distance between the surgical instrument and anatomical feature. Given the movement capabilities of the system of Taylor it would have been obvious to a person of ordinary skill in the art to provide the step of maintaining a constant distance. Further the system and method of Taylor does not preclude from providing movement of the surgical instrument relative to the anatomical feature in one axis or plurality of axis. This is further supported by the recitation to a "surgical path" of Taylor. A "surgical path" incorporated the path as claimed by applicant.

15. Regarding claim 49 Taylor does not teach the incremental movement of the "zoom" function of the surgical instrument. It is obvious to one of ordinary skill in the art at the time the invention was made to provide any available motion mechanism along the axis of view because the end result of "zoom" is satisfied. The method moving incrementally to a desired zoom or moving directly to the desired zoom provided the same image.

### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjay Cattungal whose telephone number is (571)272-1306. The examiner can normally be reached on 9:30 - 5:00 pm.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571)272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SPC

A handwritten signature in black ink, appearing to read "Brdl".